

REMARKS

In the Final Office Action¹, the Examiner took the following actions:

rejected claims 1-10, 12, 13, and 16 under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent 6,643,825 to Li et al. ("Li");

rejected claim 11 under 35 U.S.C. § 103(a) as being unpatentable over *Li* in view of U.S. Patent 6,470,381 to De Boor et al. ("De Boor");

rejected claim 14 under 35 U.S.C. § 103(a) as being unpatentable over *Li* in view of U.S. Patent 6,247,066 to Tanaka et al. ("Tanaka");

rejected claim 15 under 35 U.S.C. § 103(a) as being unpatentable over *Li* in view of U.S. Patent 5,754,840 to Rivette et al. ("Rivette"); and

rejected claim 17 without providing any specific grounds.

I. Rejection of claims 1-10, 12, 13, and 16 under 35 U.S.C. § 102(e)

Applicants respectfully request that the Examiner reconsider and withdraw the rejection of claims 1-10, 12, 13, and 16 under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent 6,643,825 to Li et al. ("Li"). In order to properly establish that *Li* anticipates Applicants' claimed invention under 35 U.S.C. § 102, each and every element of each of the claims in issue must be found, either expressly described or under principles of inherency, in that single reference. Furthermore, "[t]he identical invention must be shown in as complete detail as is contained in the ... claim." See M.P.E.P. § 2131, quoting *Richardson v. Suzuki Motor Co.*, 868 F.2d 1126, 1236, 9 U.S.P.Q.2d 1913, 1920 (Fed. Cir. 1989).

¹ The Office Action contains a number of statements reflecting characterizations of the related art and the claims. Regardless of whether any such statement is identified herein, Applicants decline to automatically subscribe to any statement or characterization in the Office Action.

Claim 1 recites, among other things, "convert[ing] data into a format compatible with the screen in window format or a format compatible with the screen in web format based on the determination [of whether a display format is dependant on an operating system of the user terminal]."

Li discloses a system that allows a user to reformat a host screen based on a selection made by the user in a graphical user interface. Col. 5, lines 55-60. The system of *Li* can use the selection to generate different styles and layouts from the same XML stream. Col. 5, lines 19-32. The styles include a "web style" and a "Plain" layout that "show[s] all fields in the traditional terminal window format." Col 6 lined 28-29 and 62-67. Neither this portion of *Li*, nor any other portion of *Li*, constitutes a teaching of "convert[ing] data into a format compatible with the screen in window format or a format compatible with the screen in web format based on the determination [of whether a display format is dependant on an operating system of the user terminal]."

Since *Li* fails to teach each and every element of claim 1, *Li* cannot anticipate claim 1. Thus, claim 1 is allowable for at least these reasons.

Independent claims 2 and 7, while of different scope, recite elements similar to those of claim 1 and are thus allowable over *Li* for at least the same reasons discussed above in regard to claim 1. Claims 4 and 6 are allowable at least due to their dependence from claim 1 or 2. Claims 8-10, 12, 13, and 16 are also allowable at least due to the dependence from claim 7.

II. Rejection of claim 11 under 35 U.S.C. § 103(a)

Applicants respectfully request that the Examiner reconsider and withdraw the rejection of claim 11 under 35 U.S.C. § 103(a) as being unpatentable over *Li* in view of

De Boor. A *prima facie* case of obviousness has not been established with respect to this claim.

"The key to supporting any rejection under 35 U.S.C. 103 is the clear articulation of the reason(s) why the claimed invention would have been obvious. . . . [R]ejections on obviousness cannot be sustained with mere conclusory statements." M.P.E.P. § 2142, 8th Ed., Rev. 6 (Sept. 2007) (internal citation and inner quotation omitted). "The mere fact that references can be combined or modified does not render the resultant combination obvious unless the results would have been predictable to one of ordinary skill in the art." M.P.E.P. §2143.01(III) (emphasis in original). "In determining the differences between the prior art and the claims, the question under 35 U.S.C. 103 is not whether the differences themselves would have been obvious, but whether the claimed invention as a whole would have been obvious." M.P.E.P. § 2141.02(I), (emphasis in original).

"[T]he framework for objective analysis for determining obviousness under 35 U.S.C. 103 is stated in *Graham v. John Deere Co.*, 383 U.S. 1, 148 U.S.P.Q. 459 (1966). . . . The factual inquiries . . . [include determining the scope and content of the prior art and] . . . [a]scertaining the differences between the claimed invention and the prior art." M.P.E.P. § 2141(II). "Office personnel must explain why the difference(s) between the prior art and the claimed invention would have been obvious to one of ordinary skill in the art." M.P.E.P. § 2141(III). Here, a *prima facie* case of obviousness has not been established because the Examiner has neither properly determined the scope and content of the prior art nor properly ascertained the differences between the claimed invention and the prior art. Accordingly, the Examiner has failed to clearly

articulate a reason why the prior art would have rendered the claimed invention obvious to one of ordinary skill in the art.

Claim 11 depends indirectly on claim 7 and thus requires each and every element of claim 7. As set forth above, *Li* fails to teach at least "means for converting data into a format compatible with a screen in window format or a format compatible with a screen in web format based on the determination" as recited in claim 7 and required by claim 11. Moreover, *De Boor* fails to cure the deficiencies of *Li*. That is, *De Boor* also fails to teach or suggest "means for converting data into a format compatible with a screen in window format or a format compatible with a screen in web format based on the determination [of whether a display format is dependant on an operating system of the user terminal]."

In view of above, the Office Action has neither properly determined the scope and content of the prior art nor properly ascertained the differences between the prior art and the invention of claim 11. Thus, no reason has been clearly articulated as to why claim 11 would have been obvious to one of ordinary skill in the art in view of the prior art. Accordingly, a *prima facie* case of obviousness has not been established. Applicants therefore respectfully request that the Examiner withdraw the rejection of claim 11 under 35 U.S.C. § 103(a) as being unpatentable over *Li* in view of *De Boor*.

III. Rejection of claims 14 under 35 U.S.C. § 103(a)

Applicants respectfully request that the Examiner reconsider and withdraw the rejection of claim 14 under 35 U.S.C. § 103(a) as being unpatentable over *Li* in view of *Tanaka*. A *prima facie* case of obviousness has not been established with respect to this claim.

Claim 14 depends from claim 7 and thus requires each and every element of claim 7. As set forth above, *Li* fails to teach at least "means for converting data into a format compatible with a screen in window format or a format compatible with a screen in web format based on the determination" as recited in claim 7 and required by claim 14. Moreover, *Tanaka* fails to cure the deficiencies of *Li*. That is, *Tanaka* also fails to teach or suggest at least "means for converting data into a format compatible with a screen in window format or a format compatible with a screen in web format based on the determination [of whether a display format is dependant on an operating system of the user terminal]."

In view of above, the Office Action has neither properly determined the scope and content of the prior art nor properly ascertained the differences between the prior art and the invention of claim 14. Thus, no reason has been clearly articulated as to why claim 14 would have been obvious to one of ordinary skill in the art in view of the prior art. Accordingly, a *prima facie* case of obviousness has not been established. Applicants therefore respectfully request that the Examiner withdraw the rejection of claim 14 under 35 U.S.C. § 103(a) as being unpatentable over *Li* in view of *Tanaka*.

IV. Rejection of claims 15 under 35 U.S.C. § 103(a)

Applicants respectfully request that the Examiner reconsider and withdraw the rejection of claim 15 under 35 U.S.C. § 103(a) as being unpatentable over *Li* in view of *Rivette*. A *prima facie* case of obviousness has not been established with respect to this claim.

Claim 15 depends from claim 7 and thus requires each and every element of claim 7. As set forth above, *Li* fails to teach at least "means for converting data into a

format compatible with a screen in window format or a format compatible with a screen in web format based on the determination" as recited in claim 7 and required by claim 15. Moreover, *Rivette* fails to cure the deficiencies of *Li*. That is, *Rivette* also fails to teach or suggest at least "means for converting data into a format compatible with a screen in window format or a format compatible with a screen in web format based on the determination [of whether a display format is dependant on an operating system of the user terminal]."

In view of above, the Office Action has neither properly determined the scope and content of the prior art nor properly ascertained the differences between the prior art and the invention of claim 15. Thus, no reason has been clearly articulated as to why claim 15 would have been obvious to one of ordinary skill in the art in view of the prior art. Accordingly, a *prima facie* case of obviousness has not been established. Applicants therefore respectfully request that the Examiner withdraw the rejection of claim 15 under 35 U.S.C. § 103(a) as being unpatentable over *Li* in view of *Rivette*.

V. Rejection of claim 17

Applicants respectfully request that the Examiner reconsider and withdraw the rejection of claim 17. Claim 17 is dependent upon claim 11 and it can only be assumed that claim 17 is rejected under the same grounds. A *prima facie* case of obviousness has not been established with respect to this claim.

The basis for this rejection is not made clear in the office action. The discussion of the rejection cites only to *Li*. (Final Office Action at pp. 11-12). Claim 17 depends indirectly on claim 7 and thus requires each and every element of claim 7. As set forth above, *Li* fails to teach at least "means for converting data into a format compatible with

a screen in window format or a format compatible with a screen in web format based on the determination" as recited in claim 7 and required by claim 17.

Although the rejection of claim 17 discusses only *Li*, the discussion of claim 11, from which claim 17 depends, cites to *De Boor*. However, *De Boor* fails to cure the deficiencies of *Li* and would not render obvious the claimed invention. That is, *De Boor* also fails to teach or suggest at least "means for converting data into a format compatible with a screen in window format or a format compatible with a screen in web format based on the determination [of whether a display format is dependant on an operating system of the user terminal]."

In view of above, the Office Action has neither properly determined the scope and content of the prior art nor properly ascertained the differences between the prior art and the invention of claim 17. Thus, no reason has been clearly articulated as to why claim 17 would have been obvious to one of ordinary skill in the art in view of the prior art. Accordingly, a *prima facie* case of obviousness has not been established. Applicants therefore respectfully request that the Examiner withdraw the rejection of claim 17 under 35 U.S.C. § 103(a) as being unpatentable over *Li* in view of *De Boor*.

Lastly, the Examiner makes numerous assertions with regard to the dependant claims under the "Response to Arguments" heading in the Final Office Action. Although Applicants do not concede these points, the Examiner's arguments fail to correct the deficiencies of the prior art, as discussed above.

In view of the foregoing remarks, Applicants submit that this claimed invention is neither anticipated nor rendered obvious in view of the prior art references cited against this application. Applicants therefore request the Examiner's reconsideration and reexamination of the application, and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge
any additional required fees to Deposit Account 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, L.L.P.

Dated: June 25, 2008

By: Robert Clemente, Jr. #27432
for Arthur S. Garrett
Reg. No. 20,338
(202) 408-4000